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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,911	08/18/2003	Michael C. Jeziak	1097-014	3192
25215	7590	12/16/2004	EXAMINER	
DOBRUSIN & THENNISCH PC			LEWIS, KIM M	
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SUITE 210			ART UNIT	PAPER NUMBER
PONTIAC, MI 48342			3743	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/642,911	JEZIAK, MICHAEL C.
	Examiner Kim M. Lewis	Art Unit 3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> .

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It states "original, first and joint inventor", yet there is only one listed inventor.

### ***Specification***

3. The use of the trademark Velcro has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 9, 12-16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As regards claims 9, 15 and 19, the trademark Velcro is used in the claims as a limitation to identify or describe a particular material or product. As such, the scope of the claim is uncertain since a trademark or trade name cannot be used properly to identify any particular material or product.

As to claims 12-16, the recitation "the method of claim 10" is indefinite in that the examiner is unclear whether the applicant intends to claim a method or a system. The applicant should note that claim 10 is a product claim and not a method claim. The examiner will, however, examine claims 12-16 as if they depend from method claim 11.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 5, 6, 9, 17 and 19 and are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,343,604 ("Beall").

As regards claim 1, Beall anticipates applicant's invention. More specifically, Beall discloses a protective non-occlusive wound shield, which is capable of protecting a newly applied body art, comprising a cover defined by: a peripheral portion (rim 2) having a mating surface for placement on a skin surface, wherein the mating surface is shaped to surround newly applied body art on the skin surface, a central portion (dome 1) joining the peripheral portion, wherein the central portion has an outer surface and an interior recessed surface; and a retention member (adhesive tape 5) adapted to affix the cover to the skin, wherein the cover is capable of being placed and affixed around and over a newly applied body art to create a gapped region between the central portion and the newly applied body art and substantially prevent destructive contact to the same (Figs. 1, 3, and 4).

As regards claim 5, the device is constructed from a thermoplastic material (Abstract).

As to claim 6, Beall discloses perforations (4), which are capable of allowing air circulation or the application of agents.

As regards claim 9, Beall discloses that the retention member is an adhesive tape.

As regards claims 17 and 19, Beall anticipates applicant's presently claimed invention. More specifically, Beall disclose a kit for protecting a wound, which is

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capable of protecting a newly applied body art. The kit comprises a dome shield (1) ~~which has~~ having a recessed interior surface and a retention member (adhesive roll tape 5).

8. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,557,804 ("Ovortrup et al.")

As regards claim 1, Ovortrup et al. anticipate applicant's presently claimed invention. More specifically, Ovortrup et al. disclose a resealing skin bandage capable of protecting a newly applied body art. The cover of Ovortrup et al. is defined <sup>by</sup> ~~as~~ a peripheral portion (circumferential rim 14) having a mating surface for placement on a skin surface (note Fig. 3), wherein the mating surface is capable of surrounding newly applied body art on the skin surface, a central portion (domed cover 16) joining the peripheral portion, wherein the central portion has an outer surface and an interior recessed surface; and a retention member (underpants 44) adapted to affix the cover to the skin, wherein placement and affixing of the cover around and over ~~the~~ newly applied body art creates a gapped region between the central portion and the newly applied body art and substantially prevents destructive contact to the same.

As regards claim 4, Ovortrup et al. disclose that the cover comprises a metal (col. 4, line 65-col.5, line 8).

9. Claims 1, 7 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,274,787 ("Downing").

As regards claim 1, Downing anticipates applicant's claimed invention. More specifically, Downing discloses a transparent, span-over-the-wound bandage

comprising a cover defined by: a peripheral portion (along the bottom edge 24) having a mating surface for placement on a skin surface, wherein the mating surface is shaped to surround newly applied body art on the skin surface, a central portion (canopy 20) <sup>a ~~wound~~ or any other object such as</sup> joining the peripheral portion, wherein the central portion has an outer surface and an interior recessed surface (22); and a retention member (adhesive 26) adapted to affix the cover to the skin, wherein placement and affixing of the cover around and over the newly applied body art creates a gapped region between the central portion and the newly applied body art and substantially prevents destructive contact to the same.

As regards claim 7, Downing discloses at col.1, lines 22-27, that "[t]he transparent span-over-the-wound bandage is manufactured of a non-penetrable [sic] material that when properly applied forms a hermetically sealed containment chamber to protect the injury from airborne contaminants and water". Also, at col. 2, lines 14-21, Downing discloses that the "...wound bandages are fabricated of a non-permeable, malleable material...". These disclosures clearly indicate that the cover is "substantially waterproof" as presently claimed.

As regards claim 17, Downing anticipates applicant's presently claimed invention. More specifically, Downing discloses a kit for protecting a wound, which is capable of protecting a newly applied body art. The kit comprises a dome shield (46) having a recessed interior surface and a retention member (base section 40)

10. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipate by U.S. Patent No. 3,334,626 ("Schimmel").

As regards claim 1, Schimmel discloses an injury protector, capable of protecting a newly applied body art. The protector comprises a cover defined by: a peripheral portion flat brim 11) having a mating surface for placement on a skin surface, wherein the mating surface is shaped to surround newly applied body art on the skin surface *an injury or any other object such as* (Fig. 2), a central portion (round crown 12) joining the peripheral portion, wherein the central portion has an outer surface and an interior recessed surface; and a retention member adapted to affix the cover to the skin, wherein placement and affixing of the cover around and over the newly applied body art creates a gapped region between the central portion and the newly applied body art and substantially prevents destructive contact to the same (col. 1, line 48-col. 2, line17).

As regards claim 3, Schimmel disclose that the protector is constructed from gauze, which is inherently flexible.

11. Claims 1, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,570,050 ("Augustine et al.").

As regards claim 1, 8 and 10, Augustine et al. disclose a bandage for autolytic wound debridement, which anticipates applicant's presently claimed invention. More specifically, as can be seen from Figs. 1 and 1a, Augustine et al. disclose a cover (bandage 10) defined by: a peripheral portion having a mating surface for placement on a skin surface, wherein the mating surface is shaped to surround newly applied body art *an injury or any other object such as* on the skin surface, a central portion joining the peripheral portion, wherein the central portion has an outer surface and an interior recessed surface; and a retention member

(adhesive 26) adapted to affix the cover to the skin, wherein placement and affixing of the cover around and over the newly applied body art creates a gapped region between the central portion and the newly applied body art and substantially prevents destructive contact to the same.

As to claim 8, Augustine et al. disclose that the bandage is constructed from open cell foam, which is inherently opaque and capable of preventing exposure of the skin to sunlight.

As to claim 10, Augustine et al. disclose at col. 5, lines 3-5, that barrier (26) is fluid-impermeable, thereby further acting to create a substantially waterproof environment.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schimmel.

As regards claim 2, Schimmel discloses that injury protector is for the minor injuries such as small wounds for children (col. 1, lines 8-11). Since tattooing results in injury to the skin, it would have been obvious to one having ordinary skill in the art to protect a tattoo with the injury protector of Schimmel in order to ensure against contact of the injury (tattoo) until the injury (tattoo) is healed.

15. Claims 11, 14-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing.

As regards claim 11, Downing substantially discloses applicant's claimed invention. More specifically, Downing discloses a method for protecting an injury in the form of a wound. The device used in the method is a transparent, span-over-the-wound bandage comprising a cover defined by: a peripheral portion (along the bottom edge 24) having a mating surface for placement on a skin surface, wherein the mating surface is shaped to surround a wound on the skin surface, a central portion (canopy 20) joining the peripheral portion, wherein the central portion has an outer surface and an interior recessed surface (22); and a retention member (adhesive 26) adapted to affix the cover to the skin, wherein placement and affixing of the cover around and over the ~~newly applied body art creates a gapped region between the central portion and the wound and substantially prevents destructive contact to the same.~~

~~an injury to the~~ ~~newly applied body art creates a gapped region between the central portion and the wound and substantially prevents destructive contact to the same.~~

Downing fails to teach a method for protecting a newly applied tattoo. However, the examiner contends that it would have been obvious to one having ordinary skill in the art to use the bandage of Downing to protect any skin injury including the injury formed by the placement of a tattoo on the skin. To use a bandage to protect injured skin regardless of how the skin injury occurs, tattoo or otherwise, is within the knowledge of one having ordinary skill in the art.

As regards claim 12, Downing discloses the step of applying a medicament to the skin injury to facilitate healing (col. 1, lines 33-38).

As regards claim 14, Downing discloses a waterproof environment, note the rejection of claim 7, *supra*.

As regards claim 15, note adhesive (26).

As regards claim 16, it is inherent that the retention member (adhesive 26) further acts to create a substantially waterproof environment by sealing the cover on the skin of the user.

As regards claim 18, Downing fails to teach the kit comprises an agent. However, Downing discloses a configuration (Fig. 6), wherein the device is provided in two pieces in order to allow for the application of an agent (col. 1, lines 33-38).

It would have been obvious to one having ordinary skill in the art to sell the medicament or ointment with the protector as a kit as an obvious design choice since Downing provides disclosure of a medicament or agent for use with the device.

16. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beall.

As regards claim 11, Beall substantially discloses applicant's method as claimed. More specifically, Beall discloses method of protecting an injury in the form of a wound. The device used in the method is a protective non-occlusive wound shield, comprising a cover defined by: a peripheral portion (rim 2) having a mating surface for placement on a skin surface, wherein the mating surface is shaped to surround newly applied body art on the skin surface, a central portion (dome 1) joining the peripheral portion, wherein the central portion has an outer surface and an interior recessed surface; and a retention member (adhesive tape 5) adapted to affix the cover to the skin, wherein the cover is capable of being placed and affixed around and over a ~~newly applied~~ <sup>wound</sup> body art to create a gapped region between the central portion and the newly applied body art and substantially prevent destructive contact to the same.

Beall fails to teach that the method is for protecting a newly applied tattoo. However, the examiner contends that it would have been obvious to one having ordinary skill in the art to use the bandage of Beall to protect any skin injury including the injury formed by the placement of a tattoo on the skin. To use a bandage to protect injured skin regardless of how the skin injury occurs, tattoo or otherwise, is within the knowledge of one having ordinary skill in the art.

As regard claim 13, note perforations (4), which allow for air circulation.

As regards claim 20, Beall fails to teach additional wound protecting devices. However, it would have been *prima facie* obvious to one having ordinary skill in the art

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to provide additional wound protecting devices, for example, different sized wound protecting devices, to accommodate various sized wounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis  
Primary Examiner  
Art Unit 3743

kml  
December 3, 2004